



Serial No. 09/313,659
SEC. 636

b

THE UNITED STATES PATENT AND TRADEMARK OFFICE

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JUL 18 2001

TC 2800 MAIL ROOM

In re Patent application of : **Group Director**
Won-Suk YANG et al. : Group 2814
Serial No. 09/313,659 : [Batch No. E95]
Filed: May 18, 1999 : [Examiner S. Rao]

URGENT

METHOD FOR FABRICATING A SEMICONDUCTOR DEVICE

URGENT

**PETITION TO (a) WITHDRAW UNAUTHORIZED
EXAMINER'S AMENDMENT, AND (b) REOPEN
PROSECUTION**

Honorable Commissioner of Patents,
Washington, D.C. 20231

Sir:

Without any authorization whatsoever from the Applicant or Applicant's representatives, the Examiner amended Claims 9, 18 and 19 of the above-identified application, presumably for the purpose of removing a rejection under 35 U.S.C. §112, first paragraph, and then passing the application to issue.

Applicant, by the undersigned, hereby petitions the Commissioner to direct the Examiner to (a) withdraw the Examiner's amendment dated July 11, 2001, and (b) reopen prosecution to properly address the rejection under 35 U.S.C. §112, first paragraph.

The facts related to this Petition are as follows:

- (1) On January 25, 2001, the Examiner issued an improper "final" Office Action.

See
Examiner's
Note, page 11
OC
8/2/01

- (2) On March 1, 2001, and March 7, 2001, telephone conferences were held between Mr. Brian Altmiller (Applicant's representative) and the Examiner. Details of these telephone conferences are described in the attached Interview Summary, which was later prepared by Mr. Altmiller and filed on April 19, 2001. In the Interview Summary, Mr. Altmiller states:

In the March 1, 2001, conversation, the Examiner indicated that he would present these arguments to his supervisor. In the March 7, 2001, conversation, the Examiner indicated that his supervisor agreed with these comments relating to the patentability of claims 1-19 over the cited prior art.

Regarding the pending rejection of claims 9 and 19 under 35 U.S.C. § 112, first paragraph, the Examiner proposed an amendment that he stated would overcome this rejection. In particular, he recommended deleting any reference to BF₂ in claims 9 and 19.

The undersigned noted that he would pass this proposed amendment to the Applicants for review. However, no final determination was made regarding any claim amendments, and the undersigned did not agree to any of the proposed amendments.

During these telephone conversations, the Examiner noted that he did not wish to withdraw the Office Action of January 25, 2001, nor did he wish to work through these matters by Examiner's Amendment. Rather, he requested that the undersigned file a response to the pending Office Action and include a reference to these telephone interviews, and the arguments made during these interviews. In particular, the Examiner specifically requested that the response address the rejection under 35 U.S.C. § 112, first paragraph, as discussed in these interviews. (Emphasis added.)

- (3) On March 7, 2001, although not of record in the Patent Office files, Mr. Altmiller then wrote to the Applicant to obtain their opinion as to the rejection under 35 U.S.C. § 112, first paragraph, and in particular to ask

whether the claims may be amended as suggested by the Examiner.

- (4) On March 15, 2001, although not of record in the Patent Office files, the Applicant replied to Mr. Altmiller's letter by rejecting the Examiner's proposed amendment and by providing detailed argument against the rejection under 35 U.S.C. §112, first paragraph. Mr. Altmiller then intended to file a response by the due date of April 25, 2001.
- (5) Surprisingly, on April 11, 2001, the Examiner issued the aforementioned Notice of Allowance, as well as the Examiner's amendment which was never authorized by the Applicant or the Applicant's representatives. The Examiner also issued an Interview Summary which makes no mention of the Examiner's proposal and/or the rejection under 35 U.S.C. §112, second paragraph.
- (6) On April 19, 2001, Mr. Altmiller prepared and filed the aforementioned Interview Summary, as well as Comments On Statement Of Reasons For Allowance, copies of which are attached. In the later document, Mr. Altmiller states:

However, contrary to the Examiner's assertion, the undersigned ***did not*** authorize the Examiner to make any amendments to any pending claims in this application.
(*Emphasis in original.*)

The unauthorized amendments of the Examiner were not of a grammatical or typographical nature, and instead were directed to obviating a rejection under 35 U.S.C. §112, first paragraph, which Applicants were preparing to traverse in a response to the

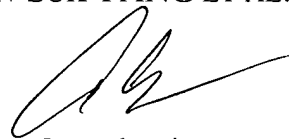
improper final Office Action of January 25, 2001.

The preemptive issuance of a Notice of Allowance and unauthorized Examiner's amendment was manifestly improper. Accordingly, Applicant's respectfully request that the Examiner's amendment be withdrawn, that the Notice of Allowance be withdrawn, and that prosecution of the application be reopened to properly resolve the issues raised in connection with the rejection under 35 U.S.C. §112, first paragraph. Also, since the finality of the January 25, 2001, Office Action was improper, Applicant requests that the Examiner be directed to issue a new non-final Office Action.

Applicant has not paid the issue fee in the application since it is believed that the Notice of Allowance will be withdrawn responsive to this Petition. However, the Commissioner is authorized to charge any fees associated with this application, including the issue fee if necessary to maintain the pendency of the application, to deposit account No. 50-0238.

Respectfully submitted,

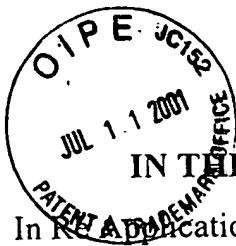
WON-SUK YANG ET AL.



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July 11, 2001

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In Re Application of:

Won-suk YANG et al.

Group Art Unit: 2814

Application Serial No.: 09/313,659

Examiner: S. Rao

Filed: May 18, 1999

Title: METHOD FOR FABRICATING A SEMICONDUCTOR DEVICE

Assistant Commissioner of Patents
Washington, D.C. 20231

COPY


COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Sir:

In the Notice of Allowability dated April 11, 2001, the Examiner indicated that the undersigned authorized amendments to claims 9, 18, and 19. However, contrary to the Examiner's assertion, the undersigned did not authorize the Examiner to make any amendments to any pending claims in this application. A discussion of the substance of the telephone interviews made by the undersigned with the Examiner are set forth in the Interview Summary being filed along with this paper.

Applicants respectfully request that the Examiner make these comments of record in this case.

Respectfully Submitted,
Jones Volentine, L.L.C.


Brian C. Altmiller
Reg. No. 37,271

Date: April 19, 2001

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Title: METHOD FOR FABRICATING A SEMICONDUCTOR DEVICE

Assistant Commissioner of Patents
Washington, D.C. 20231

INTERVIEW SUMMARY

Sir:

On March 1, 2001, and March 7, 2001, the undersigned spoke with Examiner Stephen Rao by telephone regarding the final Office Action dated January 25, 2001, issued in this case. A summary of what was discussed is given below.

During these interviews, the undersigned discussed with the Examiner the finality of the January 25th Office Action, the rejection of claims 1-19 under 35 U.S.C. § 103(a), and the rejections of claims 9 and 19 under 35 U.S.C. § 112, first paragraph.

Regarding the finality of the Office Action dated January 25, 2001, the undersigned noted that a new rejection was applied to claim 15 in this Office Action, which had not been amended in a previous response. Therefore the finality of this Office Action was improper and should be withdrawn.

The Examiner considered these arguments, but would not comment on them. Rather, he requested that the undersigned include them in a written response to the Office Action, and that the Examiner would consider them fully at that time.

Regarding the pending rejection of claims 1-19 under 35 U.S.C. § 103(a), the undersigned repeated the arguments from the response filed November 15, 2000, offering additional comments to assist the Examiner in understanding them.

In the March 1, 2001, conversation, the Examiner indicated that he would present these arguments to his supervisor. In the March 7, 2001, conversation, the Examiner indicated that his supervisor agreed with these comments relating to the patentability of claims 1-19 over the cited prior art.

Regarding the pending rejection of claims 9 and 19 under 35 U.S.C. § 112, first paragraph, the Examiner proposed an amendment that he stated would overcome this rejection. In particular, he recommended deleting any reference to BF₂ in claims 9 and 19.

The undersigned noted that he would pass this proposed amendment to the Applicants for review. However, no final determination was made regarding any claim amendments, and the undersigned did not agree to any of the proposed amendments.

During these telephone conversations, the Examiner noted that he did not wish to withdraw the Office Action of January 25, 2001, nor did he wish to work through these matters by Examiner's Amendment. Rather, he requested that the undersigned file a response to the pending Office Action and include a reference to these telephone

interviews, and the arguments made during these interviews. In particular, the Examiner specifically requested that the response address the rejection under 35 U.S.C. § 112, first paragraph, as discussed in these interviews.

On April 11, 2001, the Examiner issued a Notice of Allowance with a form PTO-413 Interview Summary. In this summary of the interviews referenced above, the Examiner correctly noted that the patentability of claims 1-19 over the prior art was discussed.

The Examiner made no mention in this Interview Summary regarding the substance of the interviews as they related to the finality of the Office Action or the rejection of claims 9 and 19 under 35 U.S.C. § 112, first paragraph. The above comments provide a description of these aspects of the interviews.

Applicants respectfully request that the Examiner make these comments of record in this case.

Respectfully Submitted,
Jones Volentine, L.L.C



Brian C. Altmiller
Reg. No. 37,271

Date: April 19, 2001

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